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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,639	11/24/2000	Richard Hans Harvey	063170.6601	3833
5073	7590	12/24/2008		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER PANNALA, SATHYANARAYA R	
			ART UNIT 2164	PAPER NUMBER
			NOTIFICATION DATE 12/24/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/721,639	<b>Applicant(s)</b> HARVEY, RICHARD HANS	
	<b>Examiner</b> Sathyanarayan Pannala	<b>Art Unit</b> 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11, 12, 15, 16 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, 12, 15, 16 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/2008 has been entered.

### ***Response to Amendment***

2. Applicant's Amendment filed on 10/13/2008 has been entered with amended claims 1, 11 and newly added claims 23-26 and it is in response to the Office Action mailed on 7/11/2008. In this Office Action claims 1-5, 11-12, 15-16 and 23-26 are pending.

### ***Specification***

3. The specification amendment filed 10/13/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as

follows: Applicant cannot add a page of document to the specification and it is treated as **new matter and it will not be entered**.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

4. Claims 1-5 are objected, because none of the claims are directed to statutory subject matter. Independent claim 1 deals with simple abstract idea of determining whether an instruction or operation and the steps of these claims are non-patentable. A claim that recites a computer that solely calculates a mathematical formula or a computer disk that solely stores a mathematical formula is not directed to the type of statutory subject matter eligible for patent protection. The claims are not producing useful, concrete and tangible results. See *Diehr*, 450 U.S. at 186 and *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139. See recent court case, *In-Re Comiskey*, \_\_, Fed. Cir, 2007\_\_ decided 9/20/2007. (see MPEP 2106(IV)(B)(2)(b)(ii)).

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 11 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 11 are phrased as "an initial information entry identifier". Applicant cited as page 3, line 27- page 4, line 2; page 9, lines 8-11 and lines 19-20. None of these citations support the claimed phrase. Again, Applicant is misinterpreting the specification and a thorough grasping of the cited reference is required.

7. Claims 11-12, 16, 18, 20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant added the new subject matter as "**computer-readable medium**" which is not supported by the specification or the drawing. Appropriate correction is required.

8. Claims 1 and 11 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. the 'in' table comprising

the information entry in a normalized format, the 'out' table comprising the information entry in a raw format.

Applicant has added a page of specification and a claiming the same as **“the 'in' table comprising the information entry in a normalized format, the 'out' table comprising the information entry in a raw format.”**

In re Wands, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988) and an undue experimentation analysis. See MPEP § § 2164- 2164.08(c).

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 11 and 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, page 2, line 8, claiming as “an initial information entry identifier” whereas the specification silent about it. Similarly claim 11, is claiming. More clarification is required.

### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claim 1 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps of determining an instruction or operation adds an entry to or removes the information entry from a database system, which can all be done mentally, and therefore do not qualify as a statutory process.

Claims 2-5, 15, 23 and 25 are also rejected under 35 U.S.C. 101 as being dependent on an independent claim 1, which has been rejected under 35 U.S.C. 101.

13. Claims 11-12, 16, 24 and 26 are rejected under 35 U.S.C. § 101, because none of the claims are directed to statutory subject matter. Independent claim 11 and the steps of this claim are non-patentable as it is software steps. A claim that recites a computer that solely calculates a mathematical formula or a computer disk that solely stores a mathematical formula is not directed to the type of statutory subject matter eligible for patent protection. Claims 12, 16, 18, 22, 24 and 26 are being dependent directly or indirectly on claim 11 and therefore, they are also rejected under the same reason. See *Diehr*, 450 U.S. at 186 and *Gottschalk v. Benson*, 409 U.S. 63, 71-72

(1972). In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139. See recent court case, *In-Re Comiskey*, \_\_, Fed. Cir., 2007\_ decided 9/20/2007. (see MPEP 2106(IV)(B)(2)(b)(ii)).

14. Claims 1 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Applicant has added a page of specification and a claiming the same as “the 'in' table comprising the information entry in a normalized format, the 'out' table comprising the information entry in a raw format.” Applicant is not allowed to add a new matter to the specification and the claim the same. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-5 and 11-12, 15-16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldorf et al. (USPA Pub. 2002/0038228 A1) hereinafter



Waldorf (effective filing date 3/28/2000), and in view of Van Etten et al. (US Patent 6,892,185) hereinafter Van.

17. As per independent claim 1 and 11, Waldorf teaches the claimed, a method for amending a database system (par. 003), the method comprising:

determining whether an instruction or operation adds an information entry to or removes the information entry from a database system (Fig. 3, par. [0062]);

amending, in accordance with the instruction or operation, the database system by adding the information entry to or removing the information entry from the database system, wherein:

adding the information entry comprises first adding the information entry to an 'out' table in the database system (Fig. 3, par. [0063]); and

removing the information entry comprises first removing the information entry from an 'in' table in the database system (Fig. 3, par. [0064]),

Waldorf explicitly teach raw data and normalized data. However, Van teaches the claimed, the 'in' table comprising the information entry in a normalized format, the 'out' table comprising the information entry in a raw format (Fig. 8, col. 7, line 57 to col.8, line 11). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to combine teaching of the cited references because Van's teachings would have allowed Waldorf's method to provide an advantage of the information transfer between a buyer and a supplier to automate and continuously update a catalog database items (col. 2, lines 5-9)

18. As per dependent claim 2, Waldorf teaches “the information is added to the ‘in’ table after being added to the ‘out’ table” (Fig. 3, par. [0063]).

19. As per dependent claim 3, Waldorf teaches “the information is removed from the ‘out’ table after being removed from the ‘in’ table” (Fig. 3, par. [0064]).

20. As per dependent claim 4, Waldorf teaches “performing one entry operation of the plurality of add and remove entry operations if the instruction or operation is determining whether the instruction modify entry information” (Fig. 3, par. [0063] and [0064]).

21. As per dependent claims 5, 12, Bachmann teaches claimed “the instructions are implemented via a directory system such as X.500 or LDAP” (Fig. 3, par. [0051]).

22. As per dependent claims 15, 16 Waldorf teaches the claimed “using the out table to retrieve a result of the search of the in table.” (Fig. 3, par. [0063]).

23. As per dependent claims 23-24, Waldorf explicitly teach raw data and normalized data. However, Van teaches the claimed, the information entry in the raw format is provided as a result of a search for the information in the normalized format (Fig. 8, col. 7, line 57 to col.8, line 11).

24. As per dependent claims 25-26, Waldorf explicitly teach raw data and normalized data. However, Van teaches the claimed, the information entry in the raw format includes the information entry as initially inputted in the database system, and wherein the information entry in the normalized format includes a searchable modification of the information entry as initially inputted in the database system (Fig. 8, col. 7, line 57 to col.8, line 11).

### ***Response to Arguments***

25. Applicant's arguments filed on 10/13/2008 with respect claims 1-5, 11-12, 15-16 and 23-26 have been fully considered but they are not moot in view new grounds of rejection.

### ***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sathyanarayan Pannala/  
Primary Examiner, Art Unit 2164

srp  
December 23, 2008